

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE TTAB

Mailed: 11 SEP 2003  
Paper No. 12  
AD

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Paul Hartmann AG

---

Serial No. 76/291,151

---

Kathleen G. Mellon of Young & Basile, P.C. for Paul  
Hartmann AG.

Idi Aisha Clarke, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

---

Before Bucher, Rogers and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 27, 2001, Paul Hartmann AG (applicant) applied  
to register the mark OMNITAPE (typed drawing) on the  
Principal Register for goods ultimately identified as  
"medicated plasters, materials for surgical and medical  
dressings, bandages and bands for medical use, namely,  
gauze, medicated gauze, and adhesive tape bandages" in  
International Class 5.<sup>1</sup>

---

<sup>1</sup> Serial No. 76/291,151. The application is based on applicant's  
ownership of German Registration No. 976,529.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d). The examining attorney held that applicant's mark as used on its goods was likely to cause confusion, to cause mistake, or to deceive in view of the cited registration for the mark OMNI-TAPE, in typed form, for:

hook-and-loop fasteners that adhere upon self-contact and padding material having hook-and-loop fasteners that adhere upon self-contact, all for medical use; namely, use in or as medical splints, straps, cinching straps and belts; breathable liner padding incorporating such hook-and-loop fasteners intended for medical use; namely, use as a liner for medical splints, straps, cinching straps and belts; medical splints, straps, cinching straps and belts for medical use; namely, restraint of the limbs and/or the body in connection with operating tables, stretchers, wheel chairs, braces, splints, crutches and the like in International Class 10.<sup>2</sup>

After the examining attorney made the refusal final, this appeal followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the

---

<sup>2</sup> Registration No. 1,901,189 issued June 20, 1995, affidavits under Sections 8 & 15 accepted or acknowledged.

evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we compare applicant's mark OMNITAPE and registrant's mark OMNI-TAPE. Both marks feature the same terms, OMNI and TAPE, in the same order. The only difference is the fact that applicant spells its mark as one word while registrant connects the words "omni" and "tape" with a hyphen. The marks are not significantly different. Seaguard Corp. v. Seaward International, Inc., 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"). Similarly, the presence of a hyphen does not significantly change the appearance of the marks. "Applicant acknowledges that its mark OMNITAPE, and the cited registered mark, OMNI-TAPE, are virtually identical." Response dated March 11, 2002, page 2. When the marks are considered in their entirety, the marks would still be pronounced identically and their meaning and commercial impression would be the same. Therefore, we agree that the marks OMNITAPE and OMNI-TAPE are virtually identical.

The next factor we consider is whether the goods of applicant and registrant are related. The key to this issue is a comparison of the goods in the application's and registration's identification of goods. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... [goods or] services recited in applicant's application vis-à-vis the ... [goods or] services recited in [a] ... registration, rather than what the evidence shows the ... [goods or] services to be").

Applicant makes several arguments to counter the examining attorney's position that the goods are related.<sup>3</sup> "While the marks may be similar, a purchaser would not associate Applicant's medical gauze and adhesive tape bandages with hook-and-loop fasteners sold to manufacturers of medical products such as splints, belts, cinching straps and restraining straps for use on operating tables, stretchers, crutches and wheel chairs." Applicant's Brief at 8. "The Registrant is selling a component to manufacturing entities." Reply Brief at 2. "A person would not go to a pharmacy and buy an OMNI-TAPE splint." Reply Brief at 2. However, the examining attorney correctly points out that registrant's goods are not limited to sales to manufacturers. Indeed, "the registration states that the goods may be used for '*use in or as medical splints.*'" Examining Attorney's Brief at 5 (emphasis in original). In as much as the registrant's identification of goods indicates that its goods can be used as medical splints, we have no basis to limit registrant's goods to those that are sold as components to manufacturers and not to the general public. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir.

---

<sup>3</sup> We have not considered applicant's evidence submitted for the first time with its appeal brief. 37 CFR § 2.142(d).

1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration").

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). Furthermore, when both parties are using virtually the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Here, we must assume that registrant's hook-and loop fasteners used as medical splints would be sold through the same channels of trade to the same purchasers as applicant's gauze, medicated gauze, and adhesive tape bandages. We simply cannot agree with applicant's assertion that the "goods are entirely different, are promoted differently, travel in different channels of trade and are sold to purchasers for different purposes."

Applicant's Brief at 12. While the goods are not the same, we have no reason to conclude that the purchasers of fasteners used as medical splints on one hand and medical gauze and adhesive tape on the other hand would not overlap. Both individuals and medical personnel may need to use and purchase both gauze and a splint at the same time. They would likely be sold in some of the same stores such as pharmacies. We are unaware of any reason why the promotion of these items would be different. While it is possible that some of registrant's products may be sold to manufacturers, the identification of goods certainly does not limit the mark to those channels of trade. While applicant has included a page from a website and argued that registrant's "goods are clearly for industrial use," (Supplemental Response to Office Action, page 1), an applicant cannot limit the scope of a registration in this

manner. Furthermore, even if the registrant only displays a single item on a web page, that does not establish that this is the only product on which registrant is using mark.

We conclude that when the marks OMNITAPE and OMNI-TAPE are used on the goods in the application and registration, there is a likelihood of confusion. We note that even if we had any doubts about whether there is a likelihood of confusion, we must resolve them in favor of the prior registrant and against the newcomer. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.